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| 10/732,890      | 12/10/2003  | James R. Lisk JR.    | 5N03.1-011          | 6906             |

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GARDNER GROFF GREENWALD & VILLANUEVA. PC  
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SUITE 800  
ATLANTA, GA 30339

EXAMINER

MENDOZA, MICHAEL G

|          |              |
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| ART UNIT | PAPER NUMBER |
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3734

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| MAIL DATE | DELIVERY MODE |
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12/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/732,890

Applicant(s)

LISK ET AL.

Examiner

Michael G. Mendoza

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/20/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,13-22 and 25-39 is/are rejected.
- 7) ☒ Claim(s) 9,11,12,23 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1 and 3-39 have been considered but are moot in view of the new ground(s) of rejection.

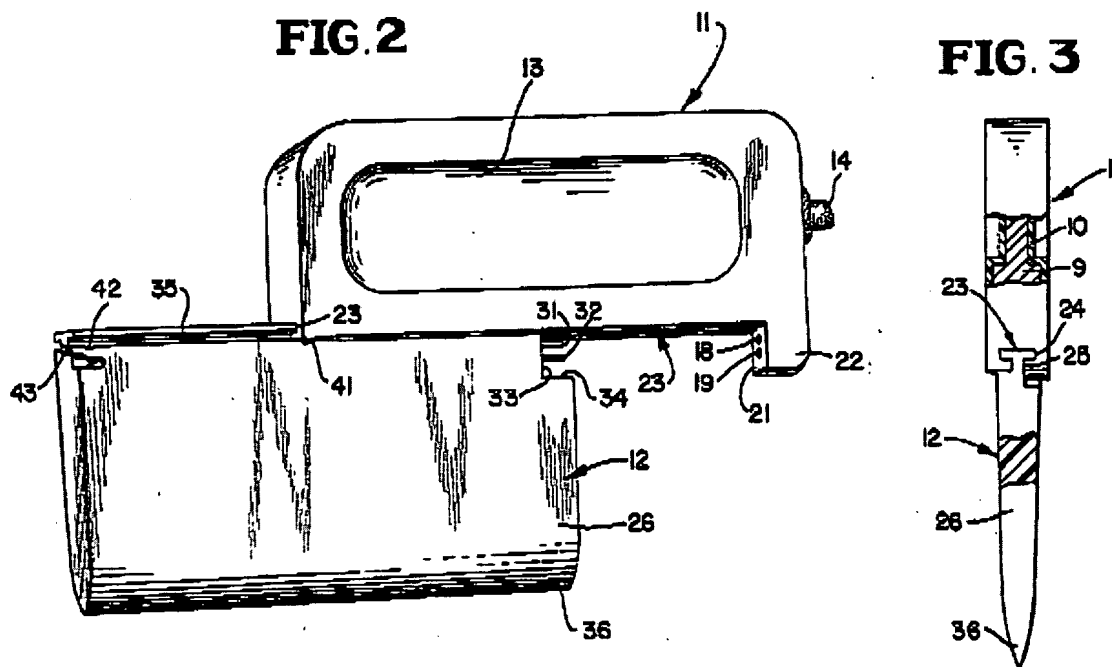
### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ours 4048471.
4. Ours teaches a separator comprising a polymeric separating edge, wherein the polymeric separating edge further comprises an inorganic filler material selected from the group of carbon powder, carbon fibers, glass powder, glass fibers, and combination thereof (col. 2, lines 36-43).



***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16-20 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Ours.

7. Ours teaches the claimed invention except for the properties of the polymeric material. Ours et al. teaches the use of polymers (col. 2, lines 36-43). These polymers are also recited in the claim limitations and can be made with the same recited

properties. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polymer having the recited structural properties, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

8. Claims 1-8, 13-20, 25, and 28-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallikaris et al. 7004953 in view of Foggia et al 5782852.

9. As to claims 1, 14, and 28-32, Pallikaris et al. teach a surgical device comprising: a positioning ring; and a separator assembly including a separator having a blunt separating edge; wherein the radius of curvature of the separating edge of the separator is between 5 micron and about 100 microns, or 10 microns and about 30 microns, or 15 microns and 25 microns (col. 6, lines 22-29).

10. Pallikaris et al. teaches that the blade can be manufactured from a material that is strong enough to push epithelium without breaking. It should be noted that Pallikaris fails to teach the preferred materials and their properties. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the recited materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Furthermore, it is known in the art to use a polymeric blade in place of a metal blade in the surgical art as evidenced by Foggia et al. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polymeric blade as taught by Foggia et al. as a mechanical expedient to a metal blade (see entire reference).

11. As to claims 3-8, 15-20, and 25, Pallikaris/Foggia teaches the claimed invention except for the properties of the polymeric material. Foggia et al. teaches the use of polymers (col. 5, lines 21-25). These polymers are also recited in the claim limitations and can be made with the same recited properties. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polymer having the recited structural properties, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

12. As to claim 26, Pallikaris/Foggia teaches the claimed invention except for the leading edge portion size range. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed range limitations, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

13. As to claim 36 and 37, Pallikaris et al. teaches a metal blade. It should be noted that Pallikaris et al. fails to teach a polymer coating on the edge of the blade. However, it is well known in the art of blades to coat the edge of a blade with a polymer, e.g., Teflon, for hardening, anticorrosive properties, or as a lubricative layer for the metal blade. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a polymer coating to the edge of the blade of Pallikaris et al. to enhance the properties of the blade.

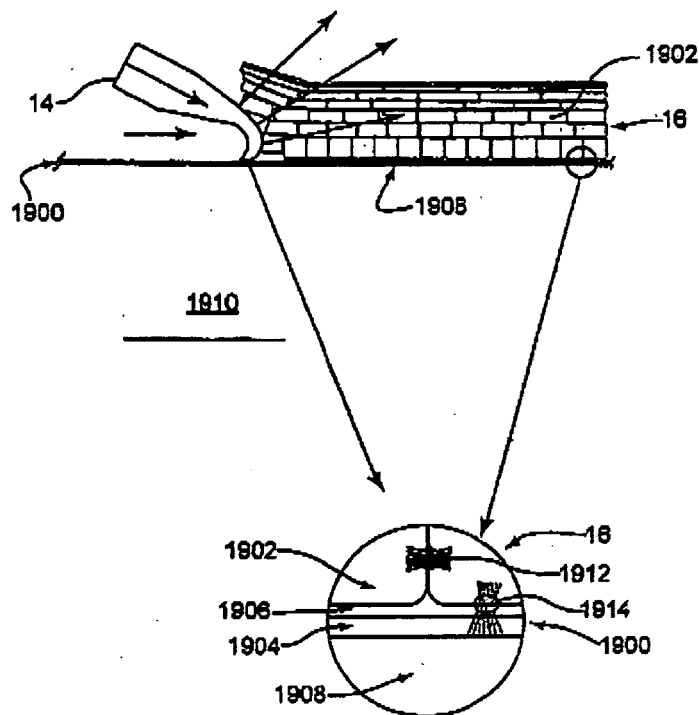


FIG. 19

14. Claim 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pallikaris/Foggia in view of Feingold 6083236.

15. Pallikaris/Foggia teaches the surgical device as claimed in claim 1. It should be noted that Pallikaris/Foggia fails to teach wherein the polymeric edge comprises a transparent material. However, Feingold teaches the use of a transparent blade (col. 6, lines 24-25). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the polymeric blade of Pallikaris/Foggia transparent for the best visibility during the process of separation.

***Allowable Subject Matter***

16. Claims 9, 11, 12, 23, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MM



Todd E Marchan  
SPE 3731